

III. REMARKS

Status of the Claims

Claims 8 and 9 have been canceled without prejudice or disclaimer. Claims 1-7 and 10-53 remain in the case. Claims 1, 2, and 42-44 are in condition for allowance. Claims 30, 32, 35, 36, 41, 52, and 53 have been amended to more clearly describe that which the Applicant considers to be his invention. Claim 40 is amended to correct a clerical error and not to narrow the claims in any way. No new matter is added by these amendments, nor is it believed that any subject matter has been surrendered.

Claim Objection

The Examiner objects to Claims 3, 5, 8, 10, 12, 16, 18, 20, 22, 24, 26-29, 31, 32, and 36 for failure to refer back to a previous claim, citing MPEP 608.01(i). The Examiner further rejects claims 4, 6, 7, 9, 11, 13-15, 17, 19, 21, 23, 25, and 30 because they depend from the claims objected to above.

MPEP 608.01(n)(F), "Handling of Multiple Dependent Claims by the Examiner" states that:

[I]n situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, all claims should be examined on the merits and no objection as to form need be made. In such cases, the examiner will renumber the claims into proper order at the time the application is allowed.

The Examiner's objection is, therefore, improper at this time as the dependence of all claims objected to is clear as presented and as the claims will be renumbered. Applicant respectfully requests that the objection be withdrawn

Claim Rejections Under 35 U.S.C. § 103

Claims 16, 29-41, and 45-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergamini. Applicant respectfully traverses this rejection.

The Examiner has not established a *prima facie* case of obviousness. Bergamini allegedly discloses the possible use of a variety of preservatives alone or in combination. Bergamini does not, however, teach or suggest the surprising synergistic effects of combining benzethonium chloride and phenoxyethanol as discussed in the present application. The applicant discloses, for example, at page 5, lines 1-10, that combining benzethonium chloride and phenoxyethanol "displays the following characteristics: (1) synergistic antimicrobial effect, allowing for a lower concentration of preservatives to be used." The applicant summarizes these surprising discoveries at page 6, lines 23-27, stating that "[t]o achieve the equivalent antimicrobial effect when used alone, the concentrations of benzethonium chloride or phenoxyethanol must each be greater than the total preservative concentration if they are used in combination and, in general, at least twice as much of the preservative must be used if employed alone." One of skill in the art could not have predicted the surprising synergistic effects of specifically combining benzethonium chloride and phenoxyethanol from the array of possible preservatives listed in the disclosure of Bergamini.

As the surprising and unexpected results disclosed in the present application could not have been predicted by one of skill in the art based on the teachings of Bergamini, Applicant respectfully requests that this rejection be withdrawn.

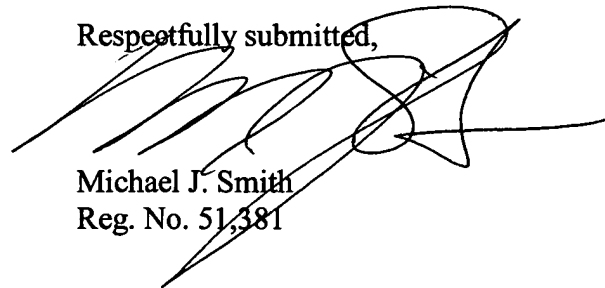
Allowable Subject Matter

The Examiner indicates that Claims 1, 2, and 42-44 are in condition for allowance. Claims 30, 32, 35, 36, 41, 52, and 53 have been amended to clarify the subject matter of those claims related to non-topical administration. It is believed those claims are now also in condition for allowance.

Conclusion

Applicant submits that, based on the Amendments and Remarks herein, the claims are in condition for allowance and such favorable action is respectfully requested. If the Examiner has any questions or comments that might accelerate allowance of these claims, he is invited to contact the undersigned representative at (512) 542-8530.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Michael J. Smith', is written over the typed name and registration number.

Michael J. Smith
Reg. No. 51,381

Vinson & Elkins L.L.P.
2300 First City Tower
1001 Fannin Street
Houston, TX 77002-6760
(512) 542-8530

Date: October 20, 2003